



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,637	04/02/2004	Paul Lapstun	HYC004US	9558
24011 7590 12/24/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
COLBERT, ELLA				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
12/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,637

Applicant(s)

LAPSTUN ET AL.

Examiner

Ella Colbert

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 1-34 are pending. Claims 1 and 18 have been amended in this communication filed 11/04/08 entered as RCE and Request for Extension of Time.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/04/08 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim limitations of claims 1-34 do not have support in the Applicants' Specification. Infact, none of the claim limitations can be found in Applicants' Specification. The closest mention of anything pertaining to the claim limitations is "a sensing device, a digital signature, a unique product item", and "a product code". The

Specification references a "network address" and does not mention a "telecommunication address". Applicants' are respectfully requested to point out in the Specification where the support for claim limitations 1-34 can be found. Applicants' claim limitations and the Specification do not agree with each other.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 in the preamble recites "A method of enabling anonymous communication ..., ..., ..., of:". "Enabling" is not a positive recitation in the preamble. A positive recitation in the preamble would be "A method of anonymous communication ..., ..., ..., of:" Claim 18 has a similar problem.

Claim 4 recites "..., wherein the computer system includes a first server, and the step of associating ...". It is unclear what the step of associating is supposed to associate. Do Applicants' mean "associating the "digital signature"? Claim 21 has a similar problem.

Claims 1-34 are also rejected because of their dependency from a rejected claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,699,528) Hogan in view of (US 6,130,666) Persidsky.

Claim 1. Hogan discloses, A method of enabling anonymous communication between a user and an application, via interaction of a sensing device with coded data printed on an interactive surface to generate interaction data, the sensing device being assigned with a unique identity, the interaction data including data on the sensing device identity, the method including the steps, performed in a computer system, of: identifying a first telecommunication address of the user using the sensing device identity data included in the interaction data (col. 2, lines 48-53); associating a temporary telecommunication address with the first telecommunication address (col. 3, line 51-col. 4, line 44); sending the temporary telecommunication address and interaction data to an application (col. 5, lines 16-43); receiving information from the application addressed to said temporary telecommunication address (col. 5, lines 44-61); and forwarding the information from the application to the first telecommunication address (col. 5, line 62-col. 6, line 30).

Persidsky discloses a sensing device with data on the sensing device (Fig. 1, col. 3, lines 8-19). Together Hogan and Persidsky disclose the claim limitations of claim 1.

Claim 18, Hogan further discloses, A system for enabling anonymous communication between a user and an application, via a sensing device with coded data printed on an interactive surface to generate interaction data, the system including a computer system configured and programmed as recited in claim 1.

This claim is rejected for the similar rationale as given above for claim 1.

Claims 2-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,699,528) Hogan in view of (US 6,130,666) Persidsky and further in view of (US 6,330,976) Dymetman et al, hereafter Dymetman.

Claims 2 and 19. Hogan and Persidsky failed to disclose, wherein the step of identifying the first telecommunication address includes determining an identity of the sensing device, and identifying the first telecommunication address from the identity. Dymetman discloses, wherein the step of identifying the first telecommunication address includes determining an identity of the sensing device, and identifying the first telecommunication address from the identity (col. 10, line 49-col. 11, line 43).

Claims 3 and 20. Hogan, Persidsky and Dymetman failed to disclose, wherein the interaction data includes a digital signature of the user and the step of identifying the first telecommunication address includes identifying the first telecommunication address recorded for a registered user identified by the digital signature. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a digital signature because this would acknowledge that the person agreed with the terms of the document contents.

Claims 4 and 21. Hogan and Persidsky failed to disclose, wherein the computer system includes a first server, and the step of associating is performed at the first server. Dymetman discloses, wherein the computer system includes a first server, and the step of associating is performed at the first server (col. 6, lines 55-65).

Claims 5 and 22. Hogan and Persidsky failed to disclose, wherein the first server is a registration server. Dymetman discloses, first server is a registration server (col. 6, lines

55-65). However, Dymetman did not expressly disclose the first server is a registration server. Since Dymetman discloses a server and a network, the first server can be a registration server.

Claims 6 and 23. Hogan and Persidsky failed to disclose, wherein the step of sending the temporary telecommunication address is performed by the first server. Dymetman discloses, wherein the step of sending the temporary telecommunication address is performed by the first server (col. 16, lines 31-46).

Claims 7 and 24. Hogan and Persidsky failed to disclose, wherein the step of associating is performed by encrypting the first telecommunication address of the user to form the temporary telecommunication address. Dymetman discloses, wherein the step of associating is performed by encrypting the first telecommunication address of the user to form the temporary telecommunication address (col. 16, lines 47-50).

Claims 8 and 25. Hogan, Persidsky, and Dymetman failed to disclose, wherein the first telecommunication address of the user is derived from the temporary telecommunication address upon receipt of the first information from the applications server by decrypting the temporary telecommunication address to which the first information was sent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt and decrypt information when information is sent over a telecommunications network for security and privacy of the information.

Claims 9 and 26. Hogan and Persidsky failed to disclose, wherein the temporary telecommunication address is provided with a unique identifier. Dymetman disclosed,

wherein the temporary telecommunication address is provided with a unique identifier (col. 18, lines 1-29).

Claims 10 and 27. Hogan and Persidsky failed to disclose, including the step, performed by the first server, of checking the unique identifier to determine whether the first server can forward the information from the application to the first telecommunication address of the user. Dymetman disclosed, including the step, performed by the first server, of checking the unique identifier to determine whether the first server can forward the information from the application to the first telecommunication address of the user (col. 18, lines 30-55).

Claims 11 and 28. Hogan and Persidsky failed to disclose, wherein the association of the temporary telecommunication address with the first telecommunication address of the user is valid for a limited number of steps of said server forwarding the information from the application to the first telecommunication address of the user. Dymetman disclosed, wherein the association of the temporary telecommunication address with the first telecommunication address of the user is valid for a limited number of steps of said server forwarding the information from the application to the first telecommunication address of the user (col. 17, lines 3-51).

Claims 12, 13, 29, and 30. Hogan and Persidsky failed to disclose, wherein the first telecommunication address of the user is selected from one of an email address, a web address, a facsimile number, a telephone number, a pager, a mobile phone number, or a Personal Digital Assistant (PDA) address. Dymetman disclosed, wherein the first telecommunication address of the user is selected from one of an email address, a web

address, a facsimile number, a telephone number, a pager, a mobile phone number, or a Personal Digital Assistant (PDA) address (col. 2, lines 55-65).

Claims 14 and 31. Hogan, Persidsky and Dymetman failed to disclose, wherein the temporary telecommunication address has the same form as the telecommunication address of the user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the same form as the telecommunication address for easier transmission and for security.

Claims 15 and 32. Hogan and Persidsky failed to disclose, wherein at least some of the coded data includes an identifier. Dymetman disclosed, wherein at least some of the coded data includes an identifier (col. 1, lines 44-67).

Claims 16, 17, 33, and 34. Hogan, Persidsky and Dymetman failed to disclose, wherein the identifier is a unique product item identifier and wherein the unique product item identifier is an electronic product code. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a unique identifier for a product and a unique product item identifier as an electronic product code to be able to know which identifier is for which product and for security purposes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zetts et al (US 5,864,635) disclosed a pen based computer.

Thompson et al (US 7,203,903) disclosed electronic representations of handwriting, printing and drawings provided by pen-based or a graphics oriented computer system.

Narayanan (US 3,835,453) disclosed a code generating and receiving apparatus having a writing instrument marking indicia on a writing surface in a code generating position.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

December 18, 2008